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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,917	06/15/2001	Cary Lee Bates	ROC920010074US1	9773
46797	7590	08/17/2006	EXAMINER	
IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829			LEROUX, ETIENNE PIERRE	
			ART UNIT	PAPER NUMBER
			2161	

DATE MAILED: 08/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/882,917

Applicant(s)

BATES ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

*Claims Status*

Claims 1-26 are pending. Claims 1-26 are rejected.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 9, 10, 12, 17, 18, 19, 21 and 25 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,718,518 issued to Plow et al (hereafter Plow).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

**Claims 1, 10, 18 and 21:**

Plow discloses:

receiving a response containing the electronic document

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automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames and

rendering the electronic document for display wherein the designated default search frame of the displayed electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame and wherein absent a command from a user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame [Fig 15, col 5, lines 1-40].

**Claims 3 and 19:**

Plow discloses wherein automatically designating occurs one of before rendering and after rendering [col 5, lines 1-40].

**Claims 4 and 12:**

Plow discloses wherein automatically designating occurs without an explicit selection of the default search frame by a user [col 2, lines 40-50]

**Claims 9, 17 and 25:**

Plow discloses highlighting the default search frame [Fig 19a]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8, 10-16, 18-24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat No 6,031,989 issued to Cordell (hereafter Cordell) and further in view of US Pat No 6,021,416 issued to Dauerer et al (hereafter Dauerer).

**Claims 1, 10, 18 and 21:**

Cordell discloses receiving a response containing the electronic document automatically designating one of the at least two frames as a default search frame based on a pre-existing specification of the default search frame, wherein the designation is made irrespective of a listed order of the frames and rendering the electronic document for display [Fig 5, col 2, lines 15-45, col 3, lines 1-20, col 14, lines 25-45]

Cordell discloses the elements of the claimed invention as noted above but does not disclose wherein the designated default search frame of the displayed electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame and wherein absent a command from a user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame. Dauerer discloses wherein the designated default search frame of the displayed electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame and wherein absent a command from a user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame [col 5, lines 35-50]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cordell to include wherein the designated default search frame of the displayed

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electronic document is available to a user for conducting a search of the searchable text contained in the designated default search frame and wherein absent a command from a user to search a different one of the at least two frames, a user request to perform a search is, by default, automatically initiated in the designated default search frame as taught by Dauerer for the purpose of searching any text within the source file [col 5, lines 6-8]

**Claims 2, 11, 13, 20 and 23:**

The combination of Cordell and Dauerer discloses the elements of claim 1 as noted above and furthermore discloses wherein the electronic document is a web page wherein the response is received from the Internet and wherein at least the automatically designating and rendering are performed by a browser [Cordell, Fig 5, col 3, lines 25-50, col 3, lines 1-20].

**Claims 3 and 19:**

The combination of Cordell and Dauerer discloses the elements of claims 1/10 as noted above and furthermore discloses wherein automatically designating occurs one of before rendering and after rendering [Cordell, Fig 5, col 3, lines 25-50, col 3, lines 1-20]

**Claims 4 and 12:**

The combination of Cordell and Dauerer discloses the elements of claims 1/10 as noted above and furthermore discloses wherein automatically designating occurs without an explicit selection of the default search frame by a user [Cordell, Fig 5, col 3, lines 25-50, col 3, lines 1-20]

**Claims 5, 14 and 22**

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The combination of Cordell and Dauerer discloses the elements of claim 1/10 as noted above and furthermore discloses parsing the response to locate a default search frame identifier [Cordell, col 3, lines 1-20].

**Claims 6 and 15:**

The combination of Cordell and Dauerer discloses the elements of claim 1/10 as noted above and furthermore discloses wherein automatically designating comprises selecting from the at least two frames a frame previously selected for a content search, wherein the frame was previously selected during a previous visit to the electronic document [Cordell, Fig 5]

**Claims 7 and 16:**

The combination of Cordell and Dauerer discloses the elements of claim 1/10 as noted above and furthermore discloses selecting from the at least two frames according to an attribute of the at least two frames [Cordell, Fig 5, col 3, lines 25-50]

**Claim 8:**

The combination of Cordell and Dauerer discloses the elements of claim 1 as noted above and furthermore discloses automatically designating comprises one of selecting from the at least two frames a frame containing a greater amount of content and selecting a largest frame from the at least two frames [Cordell, Fig 5, col 3, lines 25-50]

**Claim 24:**

The combination of Cordell and Dauerer discloses the elements of claim 21 as noted above and furthermore discloses a FRAMESET tag [Cordell, col 14, lines 30-50]

**Claim 26:**

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The combination of Cordell and Dauerer discloses the elements of claim 1 as noted above and furthermore, discloses receiving a request for a test search to be performed and as a result of the automatic designation, initiating the text search in the default search frame as opposed to any of the other at least two frames [Cordell, Fig 5]

Claims 9, 17, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Cordell and Dauerer and further in view of US Pat No 5,388,993 issued to McKiel et al (hereafter McKiel).

**Claims 9, 17 and 25:**

The combination of Cordell and Dauerer discloses the elements of claim 1/10/21 as noted above but does not disclose highlighting the default search frame. McKiel discloses highlighting the search frame [col 3, lines 40-45, Fig 1, 25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include highlighting the search frame as taught by McKiel for the purpose of assisting the user to identify a newly created frame [col 5, lines 1-10].

***Response to Arguments***

Applicant's arguments filed 6/30/2006 have been carefully considered and found persuasive but are moot based on above new grounds of rejection.



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*Contact Information*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

8/16/2006



Primary Examiner